

REMARKS

Favorable reconsideration is respectfully requested in view of the preceding amendments and the following comments. The insertion into the specification is that of inherent properties of *Saccharomyces cerevisae*, as reported in the literature, and as is well known in the art. Also summarized are inherent properties of the subject strain.

Applicants may begin at a point with their invention begins and describe what they have made that is new, and what it replaces of the old. That which is common and well known is as if it were written out in the application. *Webster Loom Co. v. Higgins*, 105 U.S. 580, 586 (1882). The specification is not addressed to lawyers or even to the public generally, but to those of ordinary skill in the art. Any description that is sufficient to apprise them (in the language of the art) of the definite features of the invention, and to serve as a warning to others of that which is claimed, is sufficiently definite. *The Carnegie Steel Company, Ltd. v. The Cambria Iron Co.*, 185 U.S. 403, 437 (1902).

The preceding two Supreme Court decisions recite holdings that have never been reversed.

Reconsideration of the restriction requirement is respectfully requested. Attention in this regard is directed to

the opinion for *In re Kuehl*, 177 U.S.P.Q. 250 (CCPA 1973), at 256:

It is in the public interest to permit claiming a method of use as well as the novel product being used in the method of use. The constitutional purpose of the patent system is promoted by encouraging applicants to claim, and therefore to describe in the manner required by 35 U.S.C. § 112, all aspects of what they regard as their inventions, regardless of the number of statutory classes involved. Dependent use claims in the same application with composition claims do not materially increase the scope of protection of an inchoate patent property under 35 U.S.C. § 154, which already includes the right to exclude others from making, using, or selling the composition by allowance of claims thereon, but they do tend to increase the wealth of technical knowledge disclosed in the patent by encouraging description of the use aspects of the invention in the manner required by paragraph one of 35 U.S.C. § 112.

The position set forth in that opinion is as valid today as it was at the time it was rendered and more than adequately justifies the examination of all of Applicants claims in this one application.

The rejection of claims 1 to 3 "under 35 U.S.C. 112, first paragraph" is respectfully traversed. A designation of the NRRL No. has been inserted in the specification and in the claims. Applicants have discovered a novel strain, which they have distinguished from other known strains and are claiming same, as they have a full right to do. They have told how to make and how to use such strain.

The rejection of claims 1 to 3 "under 35 U.S.C. 112, second paragraph" is also respectfully traversed. As a deposit under the Budapest Treaty has been made, the issues raised in this ground of rejection have thus been satisfied. Please note in this regard the two Supreme Court decisions cited in the preceding remarks. That which is known in the art need not be set forth in the specification.

Notwithstanding the foregoing, the specification has been amended to present characterizing properties of the parent species, and distinguishing properties of a subject matter to which Applicants' claims are directed. That which is well known in the art need not be set forth in the specification according to the Supreme Court. Those of ordinary skill in the art know what is in the prior art.

The rejection of claims 1 to 3 "under 35 U.S.C. 112, second paragraph" is respectfully traversed. The error pointed out in paragraph E. has been corrected by the preceding amendment.

The term "variety" has been deleted from claim 1.

The subject matter referred to in paragraph G. is addressed by the amendment of the first complete paragraph on page 9 of the specification. Basis for that amendment is provided by original claim 1.

Please note that Applicants have made a deposit under the Budapest Treaty, have amended the specification to include inherent properties of the parent species as well as distinguishing properties of their claimed subject matter.

Claiming products by properties is an accepted protocol. Reference in this regard is made to the opinions for *In re Metcalfe & Lowe*, 161 U.S.P.Q. 789, 793 (CCPA 1969); *In re Goffe*, 188 U.S.P.Q. 131 (1975); *In re Luck and Gainer*, 177 U.S.P.Q. 523 (CCPA 1973); *In re Saether*, 181 U.S.P.Q. 36 (CCPA 1974); *In re Miller*, 169 U.S.P.Q. 597 (CCPA 1971); and *Ex parte Brockman and Bohne*, 127 U.S.P.Q. 57 (PO Bd App 1959). Property limitations can serve to distinguish claimed subject matter from other products. *E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 7 U.S.P.Q. 2d 1129 (Fed. Cir. 1988).


Changes made to the specification and claims are indicated on the following pages.

Having overcome all outstanding grounds of rejection, the application is now in condition for allowance, and early action toward that and is respectfully solicited.

Respectfully submitted,

JACOBSON HOLMAN PLLC

Date: **November 18, 2002**
Customer Number 00,136
400 Seventh Street, N.W.
Washington, D.C. 20004
(202) 638-666
Atty Docket No. P66143US1


Irwin M. Aisenberg
Registration No. 19,007

CLAIMS MARKED TO SHOW CHANGES

IN THE SPECIFICATION:

Page 8 line 16, change the text of that line to read
"--Figure 1. Bio-reactor for ethanol production using BPSC-15
(NRRL Y-30630) yeast.--

Page 9, amend the paragraph starting at line 3 as follows:

--A flocculent, *Saccharomyces cerevisiae* strain BPCC-15, is deposited with USDA NRRL culture collection as NRRL Y-[xx] 30630. Under the conditions described herein, this yeast forms small, disc shaped pellets which are maintained in suspension by stirring. This yeast yields (when given a clear feed) a final beer which is still clear [less than 0.5 g/L free cells (where free cells are defined as a single and [single] double budding yeast)] with yeast pellets which settle more or less instantaneously (settling velocity of from 1 to 4 cm/s) when stirring ceases.--

IN THE CLAIMS:

1. (Amended) A biologically pure culture of *Saccharomyces cerevisiae* strain which i) [I)] has the capability to maintain a totally floc mode characterized by yeasts pellets of 0.1 to 5mm diameter in a [variety of] fermentation medium

[media], ii) shows a yeast free cell (single or budding double cells) of less than 0.5 g/L with a yeast floc density as high as 100 g/L or higher, and iii) has a limiting osmo-tolerance for ethanol productivity of about 5.0 os/kg.

2. (Amended) A biologically pure culture according to claim 1 which is that of *Saccharomyces cerevisiae* BPSC-15 (NRRL Y-30630).